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EXAMINER

NGUYEN, CUONG H

ART UNIT PAPER NUMBER

3661

DATE MAILED: 05/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/057,465

Applicant(s)

WANG, YNJIUN P.

Examiner

CUONG H. NGUYEN

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 3/21/05 (the RCE).
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

***DETAILED ACTION***

1. This Office Action is the answer to RCE received on 3/21/2005 which paper has been placed of record.
2. Claims 1-12 are pending in this application.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

- 3. Claims 1-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over as being unpatentable over Lessin et al., (US Pat. 4,868,376), in view of Joao et al. (US Pat. 6,529,725).**

A. Per claim 1: Lessin et al. suggest about permitting a user to conduct a charged transaction utilizing a charge terminal of an electronic transaction system, the charge card terminal being configured to interface with a charge card for the purpose of conducting the charge card transaction, providing a merchant card to a merchant where the charge card transaction is to be conducted (see Lessin et al., Figs.1A, 1B, 1:54-56, 3:23-26, and 2:3-4), comprising:

- accepting a merchant card and a PIN number (see Lessin et al., Fig. 4 ref.124, Fig. 10A ref. 583, Fig. 10B ref. 550, and 1:54-56).
- The examiner respectfully submits that Lessin et al.'s system is capable of detecting the use of a merchant card at a central processing area because anytime a card is used, that use is logged-in and its use is communicated to a central server (see Lessin et al., Fig.12).

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Lessin et al. do not disclose that a wireless communication means (e.g. cell-phone/(portable phone) is used to facilitate wireless communication authorization).

However, Joao et al. teach that idea. Joao et al. suggest a structure (see Joao et al., Fig.1) that:

- in response to a detection step, a call is placed to a cellular phone of a person required to authorize the charge card transaction (see Joao et al., Fig.1 ref.9), this structure is able to sending a report of the transaction to a cellular phone, and authorizing approval of the transaction back to the merchant's terminal upon approval (see Joao et al., Figs.1, 3B teach 2-way interactive communications for authorization).

It would have been obvious to one of ordinary skill in the art at the time of invention to combine teachings of Lessin et al., and Joao et al., to disclose that a wireless communication means is used to facilitate wireless communication authorization because it is necessary sometimes to get immediate approval by the authorized person especially with urgent matters.

B. Per claims 2-3: The rationales and references for rejection of claim 1 are incorporated.

Lessin et al. also teach a method for permitting a user to conduct a charged transaction utilizing a charge terminal of an electronic transaction system, wherein the merchant further enters the amount to be charged/the type of transaction to be conducted (see Lessin et al., Fig.4 ref. 124, 2:8-10). This act helps to define a required procedure.

D. As to claim 4: The rationales and references for rejection of claim 1 are incorporated.

Joao et al. also teach a method for permitting a user to conduct a charged transaction utilizing a charge terminal of an electronic transaction system, wherein the merchant card is assigned a valid credit card number, the valid credit card number of the merchant being detected to initiate the step of calling the authorizing persons cellular phone (see Joao et al., Figs.3A, 3B).

The examiner submits that using a valid credit card number to initiate a transaction is an old procedure.

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It would be obvious to one of ordinary skill in the art to use the above idea from Lessin et al.'s invention to suggest calling the authorizing persons cellular phone if a card is valid, because Joao et al. teach about making a call for notification which is analogous to an acknowledge if a credit card number/key/certificate is valid; therefore, this would help to smooth a transaction process.

E. As to claim 5: The rationales and references for rejection of claim 1 are incorporated.

Lessin et al. also teach a method for permitting a user to conduct a charged transaction utilizing a charge terminal of an electronic transaction system (see Lessin et al., Fig.20, and Fig.4 ref.124), comprising a step of filtering all credit card transactions from the charge card terminal of the merchant through a central processing server, and in response to that filtering step,

if the card number received from the merchant is not a unique merchant assigned number, then the server does nothing, Lessin et al. obviously teach that idea when checking user's input data for authentication (see Lessin et al., 14:1-4).

F. As to claim 6: The rationales and references for rejection of claim 1 are incorporated.

Lessin et al. also suggest a method for permitting a user to conduct a charged transaction utilizing a charge terminal of an electronic transaction system. Joao et al. suggest that a payment server uses the transaction associated phone number or pin number to get authorization.

It would have been obvious to one of ordinary skill in the art at the time of invention to filtering a database using indexes comprising related numbers of a subject from a combination of Lessin et al., and Joao et al. because using indexes for filtering is fast, and accurate.

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**G. As to claim 7: It is rejected under 35 U.S.C. 103(a) as being unpatentable over Lessin et al., (US Pat. 4,868,376), in view of Joao et al. (US Pat. 6,529,725), further in view of Cambier (US Pat.6,532,298).**

Lessin et al. teach a method for permitting a user to conduct a charged transaction utilizing a charge terminal of an electronic transaction system.

Lessin et al. do not disclose that a cellular phone has an imbedded PEAD.

However, Cambier teaches that idea (e.g., using an embedded chip/a simple hardware device), see Cambier, 16:31-35.

Moreover, the public has been known about using PDA for communication, a PEAD is used for personal authorization, and that PEAD would be integrated in that PDA.

Therefore, a combination of Lessin et al., Joao et al., and Cambier to utilize a cell-phone with an embedded PEAD would be obvious to one with ordinary skill in the art from Cambier's suggestion since cell-phone is merely an implementation for a communication device. This device with embedded chip would only receive intended signals for specific transactions.

**H. As to claim 8:** The combination of Lessin et al., Joao et al., and Cambier teaches a method for permitting a user to conduct a charged transaction utilizing a charge terminal of an electronic transaction system, wherein upon determining that the authorizing person's cellular phone has a PEAD, the server sends a transaction message to the authorizing person's phone for approval using a PEAD imbedded in the phone, the authorizing person approving the transaction by entering a pin number at the cellular phone.

The examiner respectfully submits that it is old and well-known to execute an authorization using a secret password, in this case, it happens to be a PIN entering on a cell-phone's keypad.

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**I. As to claim 9: It is rejected under 35 U.S.C. 103(a) as being over Lessin et al., (US Pat. 4,868,376), in view of Joao et al. (US Pat. 6,529,725), in view of Cambier, (US Pat.6,532,298), and further in view of Katz (US Pat. 5,495,284).**

The rationales and references for rejection of claim 7 are incorporated.

Lessin et al. teach a method for permitting a user to conduct a charged transaction : utilizing a charge terminal of an electronic transaction system. Joao et al. suggests the use of a wireless device for that process.

It would have been obvious to one of ordinary skill in the art to combine Lessin et al., Joao et al., Cambier, and Katz to recognize the particular operation characteristics of a touch-tone phone by looking up a database, then a server will send a message requesting a dial tone PIN for immediate approval according to the authorization process taught by Lessin et al.

**J. As to claim 10:** The rationales and references for rejection of claim 9 are incorporated:

Lessin et al. also teach a method for permitting a user to conduct a charged transaction utilizing a charge terminal of an electronic transaction system, wherein the database server utilizes an interactive voice response system to convey the transaction information to the authorizing person's cellular phone (see Joao et al., Fig.1 ref.8, and the summary).

**K. As to claim 11:** The rationales and references for rejection of claim 9 are incorporated.

Lessin et al. teach a method for permitting a user to conduct a charged transaction utilizing a charge terminal of an electronic transaction system, wherein upon the authorizing person authorizing/approving the transaction, a settlement is made to the authorizing person's account utilizing an account selected from a credit card/(a bank account).

**L. As to claim 12:** The rationales and references for rejection of claim 1 are incorporated.

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Lessin et al. also teach a method for permitting a user to conduct a charged transaction utilizing a charge terminal of an electronic transaction system, wherein the party controlling the payment server is the issuer of the merchant card.

### ***Conclusion***

5. Claims 1-12 are unpatentable.

6. These prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

- From Dialog® file 9, acc. No. 2010902, titled "With accuracy up, cost down, market grows for EDINA, MN., biometrics Co., Saint Paul Pioneer Press, 11/16/1997, wherein this article discloses that cell phone industry has been looking to authenticate and verify transactions over the phone.

- Anonymous, New products, Chain Store Age Executive, 7/1994, v70n7 (Section 1), wherein this article teaches about POS-50 having a PIN-pad interface, from U.S. Wireless Data, is a portable, fully-integrated wireless mobile credit card and check authorization terminal that enables merchants to authorize transactions anywhere cellular phone service exists.

- Resnick et al., WO 0030044 – H04K 01/00 – 5/25/2000 (priority date: 11/17/1998), Electronic payment system utilizing intermediary account, this patent discloses that account validation is a transaction to verify that an end-user account number (e.g., a cell phone number) exists in the customer database.

- Jimmy Ng K H et al., titled "Commercial transaction authorization method in e.g., departmental store, involves verifying transaction related information and requesting transaction confirmation on receiving verification approval signal", priority date: 10/26/2001 (from Dialog®



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file 350, acc. No. 015514487); this invention discloses that transaction-related information including an account identifier is received, accessed and verified with the account. An approval signal is generated upon satisfactory verification and a communication device associated with the account is contacted. Transaction confirmation is requested from the device. Commercial transaction is authorized on receiving the approval signal and the transaction confirmation.

- Mackay G, CA 2408469 – G07F 7/00 – 4/19/2003 (priority date: 10/19/2001), Payment system for vending machine purchase made through cellular telephone, has auto-attendant that verifies cellular phone user's mode of payment and provides user with authorization code for output to vending machine. This invention discloses that two-way communication with the user's cellular phone to receive requests for electronic payment for goods/services. The auto-attendant verifies the user's mode of payment and provides an authorization code to the user. A processor in the vending machine receives the authorization from the user and provides goods/services.

- Carol H. Fancher, "In your pocket smartcards," Electronic Payments, IEEE Spectrum, Feb. 1997, Motorola, Inc., pp. 47-53.

- Morrill P H – Funds transfer authenticating method for transferring funds using cellular telephones, electronic wallet, wireless PIN pad, contactless smartcard, etc., 9/11/1996. This invention discloses an advantage of highly reliable and simple technique provides desirable results since an unauthorized user with closed cellular phone would need to know unique function code, account number and personal identification number (PIN) to complete the transaction and generate a confirmation number and thus transactions of unauthorized users are not performed.

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- Graves M A., Secure data interchange system – uses intelligent card as portable device to verify that terminal is valid, which in turn verifies that card is valid, from Dialog® file 350, acc. No. 008338933 (priority date: 1/17/1989 – CA 588388).

Note: Wang (US Pats. 5,917,913 and 6,175,922) already taught the public about using PDA for communication, a PEAD is used for personal authorization, and that PEAD would be integrated in that PDA. Therefore, using a cell-phone with a PEAD would be obvious to one with ordinary skill in the art since cell-phone is merely an implementation for a communication device as said in previous Wang's patent.

Please provide support, with page and line numbers, for any amended or new claim in an effort to help advance prosecution; otherwise any new claim language that is introduced in an amended or new claim may be considered as new matter, especially if the Application is a Jumbo Application.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to CUONG H. NGUYEN whose telephone number is 571-272-6759. The examiner can normally be reached on 7:00 am - 3:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, THOMAS G. BLACK can be reached on 571-272-6956. The Rightfax number for the organization where this application is assigned is 571-273-6759.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*Cuong H. Nguyen*

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Art Unit 3661